

REMARKS/ARGUMENTS

Claims 23, 25-28 and 33, and 35-42 are active in this application.

The rejections under 35 USC 103(a) over the references of Farwick-1, Farwick-2, Farwick-3, Farwick-4, Farwick-5, Burke-1, Burke-2, Burke-3, Burke-4, Burke-5, Hans, Nampoothiri-i, Nampoothiri-2, Nampoothiri-3, Nampoothiri-4, Mockel-1, Mockel-2, Mockel-3, Dusch, Wehmeier, Dunican-i, Dunican-2, Dunican-3, Dunican-4, and Dunican-5 combined with the previously cited Kramer, Grabau, Chang and Chang are respectfully traversed because:

- (1) the subject matter of the cited patents and publications as well as the claimed invention were, at the time the claimed invention was made, owned or subject to an obligation of assignment to Evonik, formally Degussa AG or
- (2) subject to a joint research agreement that was in effect on or before the date the claimed invention was made, the claimed invention was a result of that agreement, and the parties are so named.\

The inventors Farwick, Hans and Möckel were employees of Degussa, the others were external inventors bound by an agreement (Burke and Dunican: University of Ireland/ Nampoothiri: FZJülich GmbH / Dusch and Wehmeier: University of Bielefeld)

Burke-1 corresponds to Burke-5

Burke-1, -2 and -4 are co-owned with FZJülich GmbH and University of Ireland

Burke-3 is co-owned with University of Ireland

Dunican-1, -4 and -5 are co-owned with FZJülich GmbH and University of Ireland

Dunican-2 and -3 are co-owned with University of Ireland

Application No. 10/076,416
Reply to Office Action of May 27, 2008
and the Requirement for Information, and
the PTO Notice dated January 2, 2009

Reconsideration and Withdrawal of the rejections is requested

To the rejections under the doctrine of obviousness-type double patenting (provisional or otherwise):

A terminal Disclaimer was attached to the response of September 29, 2008 for the rejection citing to U.S. 7,319,026

To the still co-pending 10/794,417; 10/483,413; 10/812,315; and 11/350,043,
Applicants request that in accordance with MPEP § 822.01:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

Indeed, as apparent with respect to many of the earlier cited co-pending applications, claims change during prosecution and therefore the present application should be allowed to issue.

To the Requirement for Information, the following patents include a claim that lists poxB as a gene, in addition to those listed at page 4 of the Requirement were identified:

7,442,530
7,320,882
7,256,021
7,241,600
7,229,802
7,172,883
7,160,711
7,160,703
7,129,066
7,037,689
6,913,912
6,911,329
6,692,946
6,689,587

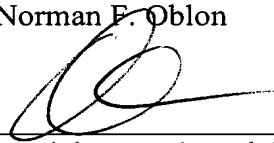
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6,623,944
6,596,516

These patents list poxB for other processes, e.g. ,making panthotenic acid, or list poxB in combination with other genes not listed in the present claims.

Should the Examiner wish to discuss any aspect of this application, he is invited to contact the Applicants' undersigned representative.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Daniel J. Pereira, Ph.D.
Registration No. 45,518

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)